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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/954,245	10/20/97	LEBOURGEOIS	J CRYP1010WSW
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EXAMINER

CALLAHAN, P

ART UNIT

PAPER NUMBER

2767

DATE MAILED:

08/13/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/954,245

Applicant(s)

LeBourgeois

Examiner

Paul E. Callahan

Group Art Unit

2767



☒ Responsive to communication(s) filed on 3 Aug 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 16, 17, and 26-28 is/are allowed.

☒ Claim(s) 1-9, 18-21, and 29-31 is/are rejected.

☒ Claim(s) 10-15, 22-25, and 32-38 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on 3 Aug 1999 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 3 Aug. 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/954,245 is acceptable and a CPA has been established. An action on the CPA follows.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-6, 18-21, and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Ensor et al., U.S. Patent No. 5,721,780.

As per claims 1 and 29 , Ensor et al. teach storing at a first time, a first signature dependent upon a first user identity and a first user system in combination; generating, at a second time subsequent to first time, a second signature dependent upon a second user identity and a second user system in combination; and certifying, in dependence upon first and second

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user signatures, whether the combination of second user identity and second user system match the combination of first user identity and said first user system (abstract and column 2, lines 31-51).

As per claim 2, Ensor et al. teach the step of storing comprising the step of developing first signature in dependence upon a first user identity code and in dependence further upon a first group of at least one component as present in first user system at first time (abstract and column 2, lines 18-37).

As per claim 3, Ensor et al. teach a method of developing a first signature comprising the step of obtaining a first user identity code in response to user input (abstract; FIG.3; and column 2, lines 31-37).

As per claim 4, Ensor et al. teach a method of storing further comprising the step of storing first signature accessibly to a certification server, and wherein step of certifying comprises the step of certification server developing a certification result in dependence upon first and second signatures (abstract and column 2, lines 31-51).

As per claims 5, 21, and 30, Ensor et al. teach a method wherein second user system is first user system (abstract and column 2, lines 31-51). When comparison of the two passwords result in a match, it is conclusive that the same user terminal, (i.e. same telephone number/identity code) is requesting access.

As per claims 6 and 31, Ensor et al. teach a method wherein step of certifying comprises the step of certifying, in dependence upon first and second signatures, whether the combination

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of second user identity and second user system match the combination of first user identity and first user system, and further that second signatures was generated at a time different from said first time (column 2, lines 38-51), subsequent time is at a time different.

As per claim 18, Ensor et al. disclose a certification method comprising the steps of: forming, at a first time, a first signature dependent upon a first user identity and a first user system in combination (abstract and column 2, lines 38-51); providing the first signature to a certification server (abstract and column 2, lines 38-51); generating, in response to an inquiry from an inquiring system at a second time subsequent to the first, a second signature dependent upon a second user identity and a second user system in combination (abstract and column 2, lines 38-51); and providing second signature for comparison with said first signature (abstract and column 2, lines 38-51).

Ensor et al. do not explicitly disclose the use of signatures or user identities. However, these features are deemed inherent to the Ensor et al. method and apparatus as the abstract and lines 38-51 of column 2 show that passwords (signatures) are generated when a connection to the telephone network is made by the user terminal (telephone line). The telephone number of the user terminal is the user identity in this disclosure.

As per claim 19, Ensor et al. disclose a method of forming a first signature comprising the step of developing first signature in dependence upon a first user identity code and in dependence further upon a first group of at least one component as present in first user system at first time (abstract; FIGS 2 & 3; and column 2, lines 18-37). It is deemed inherent that a telephone network

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is a group of at least one or more user terminals (components), where each terminal has a unique telephone number (identity code).

As per claim 20, Ensor et al. teach a method of developing a first signature comprising the step of obtaining a first user identity code in response to user input (abstract; FIG. 3; and column 2, lines 31-37).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ensor et al., U.S. Patent No. 5,721,780 as applied to claims 1 and 6 above, and further in view of Davis, U.S. Patent No. 5,796,840.

As per claim 7, Ensor et al. teach all of the limitations except a step wherein generating a second signature is performed in response to a challenge, wherein second signature is further dependent upon a challenge, and wherein the step of certifying comprises the step of developing a certification result in dependence upon first and second signatures and further in dependence upon challenge. This step is taught by Davis (figure 8). It would have been obvious to one of

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ordinary skill in the art at the time of the invention to generate a second signature in response to a challenge and develop certification results in dependence upon the challenge and signatures.

As per claim 8, Ensor et al. fail to teach a step of providing a challenge code, wherein a second signature is further dependent upon challenge code. Davis discloses a method of a second signature is dependent upon a challenge code (figure 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a second signature dependent upon a challenge code.

As per claim 9, Ensor et al. fail to teach a step of certifying comprising the step of developing a certification result in dependence upon first and second signatures and further in dependence upon challenge code. However, Davis teaches the development of a certification result in dependence upon first and second signatures and further in dependence upon challenge code (figure 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to develop certification results in dependence upon first and second signatures and further in dependence upon challenge code.

***Allowable Subject Matter***

6. Claims 10-15, 22-25, and 32-38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. Claims 16-17 and 26-28 are allowed.

8. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

9. This is a continuation of applicant's earlier Application No. 08/954,245. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however,



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event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (703) 305-1336. The examiner can normally be reached on M-Th from 9 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann, can be reached on (703) 308-7791. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

P.E.C. 08/04/1999



TOD R. SWANN  
SUPERVISORY PATENT EXAMINER  
GROUP 2700